UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,280	05/24/2001	Tsuyoshi Yamane	2001_0642A	9243

513 7590 06/03/2004

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER	
FULLER, ERIC B	
ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/863,280	YAMANE, TSUYOSHI	
	Examiner	Art Unit	
	Eric B Fuller	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2004 has been entered.

Claim Observations/Interpretations

It is noted that claim 7 had been amended to include the limitation, "wherein when said different colors are based upon the same combination of pigments, said aqueous paints not coated onto said at least one object are collected together as said excess paint". However, the claims do not require that colors based on the same combination of pigments be used in the process. Since paints are only collected together when they are based on the same combination of pigments but the process does not require that paints based on the same combination of pigments be used, a process that has different colored paints of different pigment schemes that separates each color individually reads on the applicants claims, which the applicant has admitted is known. Rejections based on Spangler as the primary reference use this interpretation of the claims. To expedite prosecution, rejections based on Gross as the

primary reference take into account paints based on the same combination of pigments being required in the process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-19, 21, and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted above, claim 7 requires collecting the paints together when the paints are based on the same combination of pigments, but does not require that the paints be based on the same combination of pigments. This renders the scope of the claim confusing.

Additionally, claim 14 requires collecting the paints separately when the paints are based on a different combination of pigments, but does not require that the paints be based on a different combination of pigments. This renders the scope of the claim confusing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-10 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Spangler (US 5,684,053).

Spangler teaches a process where a water curtain collects the overspray of an aqueous paint in a spray booth (column 1, lines 14-25). When two or more types of paints are used, the collected overspray is segregated by color and type (column 2, lines 60-64) and separated into condensed paint and filtrate by use of ultra filtration (column 4, lines 59-67). The concentrated paint is stored until it is mixed with fresh liquid paint and reused in the process (column 5, lines 7-12). The filtrate is recycled back to the spray booths (column 3, lines 56-67). Since the water-curtains read on washing the spray booth, the filtrate being recycled reads on the limitations to claim 14.

Claims 7-9 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross et al. (US 5,658,616).

Gross teaches a process where two or more aqueous paints, having different colors based on the same pigments, are sprayed onto a substrate and the overspray of both colors is washed off with water and recycled in a single collection unit (column 2, lines 30-55). Ultrafiltration is used to separate the paint from the water to make a concentrate that is mixed with fresh paint, color matched, and reused (column 2, lines 55-65; column 4, lines 1-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616), as applied to claims 7and 15 above, and further in view of Saatweber et al. (US 5,453,301).

Gross teaches the limitations of claims 7 and 15, as shown above, but is silent to a circulation water bath. However, Saatweber teaches using a circulating water bath in paint booths in order to collect overspray from the walls of the paint booth (abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the circulating water bath taught by Saatweber in the process taught by Gross. By doing so, one would reap the benefits of collecting the overspray that acquires on the walls of the spray booth.

Claims 11-13, 18, 19, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spangler (US 5,684,053), as applied to claims 7, 10, and 17, and further in view of Hayahara et al. (US 4,913,198).

Spangler teaches the limitations of claims 7, 10, and 17, as shown above, but is silent to using computer-color-matching equipment. However, Hayahara teaches that computer-color-matching devices are well known in the art as a rapid and easy method

to analyze and control coloring of paints (column 1, lines 14-40). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a computer-color-matching device when reusing the overspray (combining with fresh paint) or producing fresh paint, as taught by Spangler. By doing so, the color of the paint is easily and rapidly controlled.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616), as applied to claim 7, and further in view of Hayahara et al. (US 4,913,198).

Gross teaches the limitations of claim 7, as shown above, but is silent to using computer-color-matching equipment. However, Hayahara teaches that computer-color-matching devices are well known in the art as a rapid and easy method to analyze and control coloring of paints (column 1, lines 14-40). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a computer-color-matching device when reusing the overspray (combining with fresh paint) or producing fresh paint, as taught by Gross. By doing so, the color of the paint is easily and rapidly controlled.

Claims 11-13, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616) and Saatweber et al. (US 5,453,301), as applied to claims 10 and 17, and further in view of Hayahara et al. (US 4,913,198).

Gross, in view of Saatweber, teaches the limitations of claims 10 and 17, as shown above, but is silent to using computer-color-matching equipment. However, Hayahara teaches that computer-color-matching devices are well known in the art as a rapid and easy method to analyze and control coloring of paints (column 1, lines 14-40). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a computer-color-matching device when reusing the overspray (combining with fresh paint) or producing fresh paint, as taught by Gross. By doing so, the color of the paint is easily and rapidly controlled.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 5,658,616) and Saatweber et al. (US 5,453,301), as applied to claim 10, and further in view of Spangler (US 5,684,053).

Gross, in view of Saatweber, teaches the limitations of claims 10 and 17, as shown above, but fails to explicitly teach washing the paint booth when changing colors that are based on different pigment combinations. However, Spangler teaches that when two or more types of paints are used, the collected overspray is segregated by color and type (column 2, lines 60-64) and separated into condensed paint and filtrate by use of ultra filtration (column 4, lines 59-67). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to segregate the collected paints by color and type when the different colors are based on different pigment combinations. By doing so, one would have a reasonable expectation of success, as the negative effects of mixing unlike paints would be avoided. Since the

water-curtains read on washing the spray booth, the filtrate being recycled reads on the limitations to claim 14.

Response to Arguments

Applicant argues that the amendments filed overcome the rejections of the previous Office Action. Examiner agrees and has withdrawn the rejections accordingly. However, applicant's arguments are moot in view of the new grounds of rejection.

Applicant's arguments stated: "[During a personal interview] Examiner Fuller did express, however, that the rejections of record could be overcome by amending claim 7 to delete therefrom the phrase "irrespective of said color", while at the same time reciting in this claim that two paints having different colors which are based upon the same pigments are collected as an excess paint." It is noted that the amendment does not supply a positive recitation of "two paints having different colors which are based upon the same pigments are collected as an excess paint".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (571) 272-1420. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck, can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBF

SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700